

## **REMARKS**

The above amendments and these remarks are responsive to the Office action dated September 7, 2005. Claims 1-19 are pending in the application. Claims 1-19 have been rejected. In view of the following remarks, Applicants respectfully request reconsideration of the rejected claims under 37 C.F.R. § 1.111.

Applicants wish to thank the Examiner for the careful review of the present application and of the prior art.

### **Obviousness-Type Double Patenting**

The Examiner has rejected claims 1-19 under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-26 of commonly owned United States Patent No. 6,641,328.

In particular, the Examiner suggests that the claims of the '328 patent set forth all of the claimed recitations in the instant invention.

Without acknowledging the propriety of the rejection, Applicants hereby submit an executed Terminal Disclaimer over the '328 patent (Form PTO/SB/26), accompanied by payment of the required statutory disclaimer fee. Applicants therefore respectfully submit that the rejection is rendered moot.

### **Rejections under 35 U.S.C. § 102**

The Examiner has rejected claims 1-6, 9-11, 14 and 19 under 35 U.S.C. § 102(e) as being anticipated by Faircloth Jr. (U.S. Patent No. 5,820,751).

Applicants respectfully submit that the Faircloth Jr. reference fails to satisfy the requirements for a finding of anticipation of independent claim 1. In this regard, the standard for an anticipation rejection under 35 U.S.C. §102 has been well established by the Court of Appeals for the Federal Circuit, and is summarized in M.P.E.P. § 2131:

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). ... “The identical invention must be shown in as complete detail as is contained in the ... claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990). ...”

Independent claim 1 recites:

1. An apparatus for extracting liquid from a body of liquid, the apparatus comprising:
  - a) a conduit terminator operable to terminate a conduit, said conduit terminator having an inlet opening to facilitate conduction of liquid from said body of liquid;

- b) a solid object diverter comprising at least one solid wall surrounding said inlet opening to define a liquid admitting cavity about said inlet opening to impede solid objects from entering said inlet opening while permitting entry of liquid into said cavity for admission into said inlet opening; and
- c) a positioner operable to position said diverter in a position in said liquid body such that said cavity admits liquid from said body of liquid while said inlet opening admits liquid from said cavity.

Faircloth Jr. discloses a mesh-type water skimming apparatus, similar to that discussed in the Background section of Applicants' specification (see e.g. paragraph [0005] of the official publication of the present application, U.S. Patent Publication No. 2004/0247394 A1).

Applicants respectfully submit that Faircloth Jr. fails to disclose "a solid object diverter comprising at least one *solid* wall *surrounding* said inlet opening to define a liquid admitting cavity about said inlet opening" as recited in claim 1 (emphasis added). Regarding this element of claim 1, the Examiner has stated that, "Faircloth discloses a solid object diverter ... seen as frame (52) and screens (64, 64') in windows (63, 63')", which define a liquid admitting cavity, seen as the holes in the screens (64, 64'). At least one solid wall is seen as the solid wall parts of frame (52) in Fig. 5.". However, Applicants respectfully submit that neither this nor any other structure disclosed in

Faircloth Jr. amounts to “at least one solid wall surrounding said inlet opening”, within the meaning of claim 1.

While Applicants acknowledge that the claims should be given their broadest reasonable interpretation, they respectfully suggest that this broadest reasonable interpretation must also remain consistent with the teaching of the specification, and must also be consistent with the interpretation that those skilled in the art would reach (*In re Hyatt*, 54 U.S.P.Q. 2d 1664, 1667 (Fed. Cir. 2000) and *In re Cortright*, 49 U.S.P.Q. 2d 1464, 1468 (Fed. Cir. 1999, discussed in M.P.E.P. § 2111). Effectively, as stated in M.P.E.P. § 2111.01.I,

“the words of the claim must be given their plain meaning unless applicant has provided a clear definition in the specification. *In re Zletz*, ... 13 U.S.P.Q. 2d 1320, 1322 (Fed. Cir. 1989) ...” [emphasis added]

The “plain meaning” refers to the ordinary and customary meaning given to the term by those of ordinary skill in the art. As stated in M.P.E.P. § 2111.01.II,

“[T]he ordinary and customary meaning of a claim term is the meaning that the term would have to a person of ordinary skill in the art in question at the time of the invention ... *Phillips v. AWH Corp.*, ... 75 U.S.P.Q.2d 1321 (Fed. Cir. 2005)  
...

... The ordinary and customary meaning of a term may be evidenced by a variety of sources, ... including: ... dictionaries and treatises, *Tex Digital Sys., Inc. v. Telegenix, Inc.*, ... 64 U.S.P.Q. 2d 1812, 1818 (Fed. Cir. 2002); and the written description, the drawings, and the prosecution history ...” [emphasis added]

With respect to such relevance of dictionaries and treatises, Applicants respectfully submit that the following dictionaries provide evidence of the plain, ordinary and customary meaning of the word “solid” as used in the context of the “at least one solid wall surrounding said inlet opening” in claim 1:

- **solid** ... *adjective* ... 1 ... c : not interrupted by a break or opening <a solid wall> ... (*Merriam-Webster Online Dictionary*, <http://www.m-w.com/cgi-bin/dictionary>, as of January 30, 2006);
- **solid** ... *adj* ... having no break or interruption ... ([*Webster's Ninth New Collegiate Dictionary* (Springfield, Ma: Merriam-Webster Inc., 1987), p.1122);
- **solid** ... 1. *adj.* ... || continuous ... || without openings ... (*The New Lexicon Webster's Dictionary of the English Language* (New York: Lexicon Publications, Inc., 1987) at p.944);

- **solid** ... *adj.* ... 10. Without gaps, crevices, or breaks ... (*Webster's II New Riverside Dictionary* (New York: Berkley Books, 1984) at p.657);
- **solid** ... *adj.* ... 1 ... c: not interrupted by any break or opening ... (*Webster's Third New International Dictionary of the English Language Unabridged* (New York: G. & C. Merriam Company, 1966) at p.2169);
- **solid** *adj.* ... 4 ... continuous, unbroken ... 10 ... continuous; uninterrupted, undivided, unbroken ... (L. Urdang, *The Oxford Thesaurus: An A-Z Dictionary of Synonyms* (Oxford: Oxford University Press, 1991) at p.452.  
[emphasis added]

Thus, Applicants respectfully submit that the plain, ordinary and customary meaning of the term “solid wall” recited in claim 1 is a wall that is not interrupted by a break or opening. The closed loop vertical wall 70 shown in Fig. 2 is discussed in paragraph [0039] of Applicants’ published application as an example of such a “solid wall”.

Moreover, Applicants respectfully note that the foregoing meaning of “solid wall” is entirely consistent with Applicants’ specification, in which conventional mesh-type extraction devices similar to Faircloth Jr. are described in paragraph [0005] as disadvantageously being susceptible to clogging of the mesh, which may be contrasted to the use of a solid wall such as the vertical wall 70 disclosed in paragraph [0039] and Fig.

2, which advantageously avoids such clogging. Applicants respectfully submit that the notional person of ordinary skill in the art to whom the specification is addressed, when properly construing the term “solid wall” in accordance with its plain and ordinary meaning and in the context of the specification as a whole, would not interpret “solid wall” as encompassing a non-solid mesh such as that disclosed in Faircloth Jr.

Applicants further respectfully note that the foregoing meaning of “solid wall” is entirely consistent with the prosecution history of the present application and of its parent application serial no. 09/527,416 (now Patent No. 6,641,328), in connection with which Applicants have consistently taken this position regarding the meaning of the term “solid wall”.

Returning to Faircloth Jr., as noted, the Examiner has stated in the Office Action that “solid wall parts of frame (52) in Fig. 5” correspond to the claimed solid wall. However, Applicants respectfully note that independent claim 1 does not recite a “wall having one or more solid parts”; rather, independent claim 1 recites “at least one solid wall surrounding said inlet opening”. Thus, whether the frame (52) of Faircloth Jr. has one or more solid parts is not relevant to claim 1; rather, the issue is whether Faircloth Jr. discloses a “solid wall surrounding said inlet opening” as recited in claim 1. As previously noted, the ordinary and customary meaning of the term “solid wall” is a wall that is not interrupted by any breaks or openings, and this meaning is consistent with the specification and the prosecution history. In contrast, Faircloth Jr. discloses that the frame 52 has several breaks and openings, including an access hole 60, as well as large holes or “windows” 63 and 63’ that have been cut into the frame on opposite sides of the access

hole 60 for placement of mesh screens 64 and 64'. See column 5, lines 11-21 and Fig. 5 of Faircloth Jr. Accordingly, the frame 52 of Faircloth Jr. is not a "solid wall" as recited in claim 1, and therefore, Faircloth Jr. fails to disclose this element of claim 1. For this reason alone, Applicants respectfully submit that the Faircloth Jr. reference fails to satisfy the above-noted requirements for a finding of anticipation of claim 1, and respectfully requests that the rejection of claim 1 be withdrawn.

Although the foregoing should be technically sufficient to overcome the rejection of claim 1, Applicants also wish to offer the following additional observations regarding related limitations of claim 1. In this regard, claim 1 does not merely recite a "solid wall"; rather, the "solid wall" is recited in subparagraph b) of claim 1, which recites,

"a solid object diverter comprising at least one solid wall surrounding said inlet opening to define a liquid admitting cavity about said inlet opening to impede solid objects from entering said inlet opening while permitting entry of liquid into said cavity for admission into said inlet opening".

On page 3 of the Office Action, the Examiner has compared the "frame (52) and screens (64, 64') in windows (63, 63')" of Faircloth Jr. to the "solid object diverter" recited in claim 1. Applicants agree that all of these structures of Faircloth Jr. must be considered together in relation to the "solid object diverter" recited in claim 1, because claim 1 recites that the solid object diverter comprises "at least one solid wall surrounding said inlet opening". To the extent that Faircloth Jr. may arguably disclose



any structure surrounding an inlet opening, such structure must necessarily include, at a minimum, the frame 52, the mesh screens 64 and 64', and the caps 54 and 54' shown in Fig. 5. Anything less than this combination of structures could not reasonably be argued to be "surrounding said inlet opening" as recited in claim 1. Thus, even if the Examiner may view certain solid portions of the frame (52) as a "solid wall", such portions are not a solid wall "surrounding said inlet opening", as recited in claim 1. Conversely, the only structure in Faircloth Jr. that can reasonably be argued as surrounding an inlet opening consists of the combination of the frame 52, the mesh screens 64 and 64' and the caps 54 and 54'. Due to the numerous holes, breaks and interruptions in these structures, this combination of structures is not a "solid wall" as recited in claim 1. From either perspective, Faircloth Jr. fails to disclose "a solid object diverter comprising at least one solid wall surrounding said inlet opening", as recited in claim 1.

Likewise, also on page 3 of the Office Action, in identifying the portions of Faircloth Jr. that the Examiner felt were pertinent to the "liquid admitting cavity" recited in claim 1, the Examiner has referred to "frame (52) and screens (64, 64') in windows (63, 63'), which define a liquid admitting cavity". Thus, even if the Examiner may view certain solid portions of the frame 52 as a "solid wall", such solid portions of the frame 52 do not "define a liquid admitting cavity about said inlet opening" as recited in claim 1. Rather, the Examiner appears to have viewed the liquid admitting cavity as being defined by the larger combination of the frame (52) and the screens (64, 64'). Consistent with Applicants' submissions in the preceding paragraph, Applicants respectfully submit that nothing less than the combination of the frame 52, the screens 64, 64' and the caps 54,

54' of Faircloth Jr. can reasonably be argued to define a liquid admitting cavity. Again, due to the numerous holes, breaks and interruptions in these structures, this combination of structures does not amount to a "solid wall". From either perspective, Faircloth Jr. fails to disclose "a solid object diverter comprising at least one solid wall surrounding said inlet opening to define a liquid admitting cavity about said inlet opening", as recited in claim 1.

Accordingly, for these additional reasons, Applicants respectfully submit that the Faircloth Jr. reference fails to satisfy the above-noted requirements for a finding of anticipation of claim 1, and respectfully requests that the rejection of claim 1 be withdrawn.

Claims 2-6, 9-11 and 14 are directly or indirectly dependent upon independent claim 1. Applicants further respectfully submit that method claim 19 is also dependent upon claim 1, as it relates to a method of use of the apparatus of claim 1 and therefore effectively includes all of the limitations of claim 1. Applicants therefore respectfully submit that claims 2-6, 9-11, 14 and 19 are allowable due to their dependencies, as well as the additional subject-matter that each of these claims recites.

### **Rejections under 35 U.S.C. § 103**

The Examiner has rejected claims 7 and 8 under 35 U.S.C. § 103(a) as being unpatentable over Faircloth Jr. as applied to claim 2 above, and further in view of Truebe et al. (WO 98/56241). The Examiner has also rejected claim 12 over Faircloth Jr., claim 13 over Faircloth Jr. in view of Araki et al. (U.S. Patent No. 5,081,582), claims 15 and 16

over Faircloth Jr. in view of Smith (U.S. Patent No. 5,020,940), claim 17 over Faircloth Jr. in view of Sanders (U.S. Patent No. 5,491,922), and claim 18 over Faircloth Jr. in view of Harding (U.S. Patent No. 4,518,495).

In particular, the Examiner suggests that Faircloth discloses the limitations of the claimed invention except for a turbulence producing mechanism such as a venture accelerator formed by the housing or in the housing. As discussed above, Applicants have demonstrated that the Faircloth reference fails to disclose each and every element of independent claim 1.


As Claims 7, 8, 12, 13 and 15-18 are directly or indirectly dependent upon independent claim 1. Applicants therefore respectfully submit that these claims are allowable due to their dependencies, as well as the additional subject-matter that each of these claims recites, which is neither disclosed nor suggested by the cited references, taken singly or in combination.

It is now believed that the subject patent application has been placed in condition for allowance, and such action is respectfully requested. If the Examiner has any questions or concerns, or if a telephone interview would in any way advance prosecution of the application, please contact the undersigned agent of record.

The Commissioner is hereby authorized to charge any additional fees which may be required, or credit any overpayment to Deposit Account No. 11-1540.

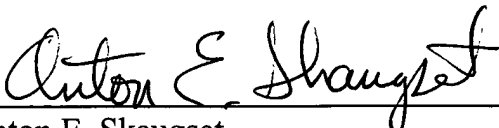
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Suzanne Lukas-Werner

Respectfully submitted,

KOLISCH HARTWELL, P.C.

  
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Anton E. Skaugset  
Registration No. 38,617  
Customer No. 23581  
Agent for Applicant  
520 S.W. Yamhill Street, Suite 200  
Portland, Oregon 97204  
Telephone: (503) 224-6655  
Facsimile: (503) 295-6679